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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,741	06/21/1999	SHERMAN CHING MA	X/P6396US0	8007

881 7590 11/19/2008  
STITES & HARBISON PLLC  
1199 NORTH FAIRFAX STREET  
SUITE 900  
ALEXANDRIA, VA 22314

EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3685

MAIL DATE	DELIVERY MODE
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11/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/336,741	<b>Applicant(s)</b> MA, SHERMAN CHING	
	<b>Examiner</b> CALVIN L. HEWITT II	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-34 and 49-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-34 and 49-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8-1-08</u> .                                                  | 6) <input type="checkbox"/> Other: _____                          |

***Status of Claims***

1. Claims 28-34 and 49-61 have been examined.

***Response to Amendments/Arguments***

2. Applicant is of the opinion that the prior art does not teach removing redundancies among multiple sets of data (Remarks, 6-12-08, page 3, lines 1-11). However, the claims are silent such a recitation and while claims are interpreted in light of the specification, limitations from the specification are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). Further, as claim 28 merely recites “computing means... to store or access a superset of non-redundant approval criteria...” and does not have a limitation describing the claimed apparatus programmed (say) for removing redundant approval criteria, then the type of criteria stored by the computing means is non-functional descriptive material and it has been held that stored data that is not functionally related to the device on which its stored will not differentiate the claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). This same analysis applies to claim 32.

Applicant is also of the opinion that the website of Hartman is not a "form" (Remarks, 6-11-08, page 4, first full paragraph). The Examiner respectfully

disagrees. According to Microsoft Press Dictionary, a “form” is a “structured document with spaces reserved for entering information and often containing special coding as well”, therefore, as the webpage of Hartman comprises fields, special coding and is used for entering information via the fields (figures 8A-C; column 9, lines 5-54) it is necessarily a form. Hence, as Hartman teaches where after completing a first form, the system constructs and presents a second, and subsequent forms containing subsequent information, on the basis of information provided by an applicant in the first form and an applicant sending these forms to a remote system (figure 1A; column 4, lines 44-58; column 9, lines 5-54), teaches steps b)-d) of claim 31. The same analysis applies to claims 49, 51, 52, 56, 59, and 60.

In addition, the Examiner is maintaining the 112 rejection, as the claim is directed to an apparatus but recites a method step (“application requested by queries...”).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 is directed to an apparatus. Claim 28 also has been amended to recite the method step of “application requested by queries...”. However, it has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim does not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548).

Claims 29-31 and 49-55 are also rejected as they depend from claim 28.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 28, 29, 32, 33, 50, 53-55, 57, 58 and 61 are rejected under

35 U.S.C. 103(a) as being unpatentable over Tengel et al. U.S. Patent No. 5,940,812.

As per claims 28-30, 32-34, 50, 53-55, 57, 58 and 61 Tengel et al. teach an apparatus for receiving and assessing an application comprising:

- computing means to store a superset of approval criteria for a plurality of application recipients (abstract; column 7, lines 28-39; column 11, lines 39-48)
- requesting that the applicant provide application information (figure 5)
- receiving the application information (figure 1)
- accessing the approval criteria of the recipients (abstract), assessing the application according to said approval criteria of each of said recipients (abstract; figure 2A) and forming a separate assessment of said application for each of said recipients (figures 2A and B)
- presents a number of questions, that include an introductory in sequence to an applicant, receives responses to said questions and optimizes the sequence (figure 5)
- computing means for an applicant to input data into said application (figure 2A) and communication means for

communicating assessments of said application to said applicant (figure 2A)

- questions that comprise a group of questions wherein at least of one of said groups include an introductory sentence (“In addition to...” figure 5) and refraining from asking questions deemed non-critical (figure 5)
- determining what application information is required to assess the application against the superset of approval criteria (abstract; figures 2A-3B and 5; column 6, lines 46-61)

Tengel et al. also teach each application recipient forming an approval or rejection assessment of the application (column 9, lines 22-26) and communicating approvals to a user (figure 2B). Regarding, “repeated criterion”, according to the teachings of Tengal et al. recipients can have the same criterion. Therefore, a “repeated criterion” is at least obvious in light of teachings Tengal et al. (abstract; figure 3; column 7, lines 28-39; column 9, lines 11-21; column 11, lines 39-48).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel et al. U.S. Patent No. 5,940,812 in view of Lent et al. U.S. Patent No. 6,405,181.

As per claims 30 and 34, Tengel et al. teach rejecting an application based on criteria such as FICO scores, payment performance and demographics (figures 3A and 3B). Tengel et al. disclose sending to an applicant approval assessments (figure 2A), however, the Tengel et al. teaching does not specifically recite communicating rejection assessments to applicants. Lent et al. teach conveying (column 10, lines 25-30; column 12, lines 45-63) to a user the reasons for rejecting an application wherein the rejection is based on FICO scores, payment performance and/or demographics (column 5, lines 15-43; column/line 7/54-8/12; column 10, lines 1-15 and 39-55; column/line 10/59-11/3). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Tengel et al. and Lent et al. in order to provide ways that for improving her or his credit score ('181, column 12, lines 50-55).



8. Claims 31, 49, 51, 52, 56, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel et al. U.S. Patent No. 5,940,812 in view of Hartman et al. U.S. Patent No. 5,960,411.

As per claims 31, 49, 51, 52, 56, 59, and 60, Tengel et al. teach a system for processing user loans by receiving and storing lender loan criteria, receiving a borrower application then comparing the application against lender criteria to determine an available loan(s) for the borrower. Specifically, Tengel et al. teach potential borrowers filling out an application (figure 5). However, Tengel et al. do not explicitly recite presenting to a user a series of forms. Hartman et al. teach a filling out an application wherein the application comprises multiple electronic forms (abstract; figures 1A-2, 8A-C). The Hartman et al. teaching allows a user to complete an application by providing a sequence of forms to a user where the requesting of unnecessary information, and redundant, in these forms is avoided (figures 1C, 3, 4, figures 8A-C; column 2, lines 59-67; column 4, lines 35-58; column 5, lines 8-26; column 7, lines 3-23; column 9, lines 8-53). More specifically, Hartman et al. disclose a method where after completing a first form, the system constructs and presents a second, and subsequent forms containing subsequent information, on the basis of information provided by an applicant in the first form and an applicant sending these forms to a remote system (figure 1A; column 4, lines 44-58; column 9, lines 25-53). Regarding “defects”, Hartman et al. teach a system for detecting “errors”, therefore as this feature is not

inherent to a computer and has to be programmed, a decision has to be made as to what is an error. Hence, a “defect” such as not capitalizing a name can be ignored by the system. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Tengel et al. and Hartman et al. in order to ensure efficient and accurate loan form processing by correcting errors in data fields (‘411, column 9, lines 35-42) that coincide (‘812, figures 3A-B and 5) with all or some lender criteria.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 3600  
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

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/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685